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10/645,724

08/20/2003

Paul Edwin Jones

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7590

08/22/2008

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EXAMINER

JUNTIMA, NITTAYA

ART UNIT

PAPER NUMBER

2616

MAIL DATE

DELIVERY MODE

08/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|--|--|---|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | <p>Application No. 10/645,724</p> | <p>Applicant(s) JONES ET AL.</p> | |
| | <p>Examiner NITTAYA JUNTIMA</p> | <p>Art Unit 2616</p> | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 40.
Claim(s) rejected: 1-11, 13-39, 41 and 42.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/FIRMIN BACKER/
Supervisory Patent Examiner, Art Unit 2616

Continuation of 11. does NOT place the application in condition for allowance because:

Regarding the arguments in the Remarks on pages 8-11 regarding claims 1, 5, 15, 21, 26, 31, 35, 36 that Riikonen fails to teach the identical invention in as complete detail as is contained in the claim, the Examiner respectfully disagrees. Because there are no differences in structure or function between the claimed limitations and the elements as identified in Riikonen (see the Final Office action dated 3/13/2008), therefore, it is respectfully submitted that Riikonen teaches all the limitations as claimed. It is also noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, in the Remarks of the Amendment dated 12/13/2007 responding to the Non-final Office action dated 9/13/2007, the applicant failed to argue on the rejection made to these limitations (with an exception of the limitation "the delay point indicating at least one of feature discovery of the called endpoint and call supplementary services"). In fact, on page 9, first paragraph of the Remarks dated 12/13/2007 indicates that the applicant actually agreed with the Examiner that "Riikonen thus teaches a SIP INVITE message, which advertises to the callee terminal to delay a designated SIP response message until the multimedia content is downloaded from a URL indicated in the "Synchronized Loading" header of the SIP INVITE message, " which is consistent with the teaching of the specification on page 1, lines 4-9 on the capability to initiate a call without completing it, delay alerting the called user.

Thus, all claim limitations are met by Riikonen and the rejection is maintained.

Regarding the arguments in the Remarks on pages 11-12 regarding claims 1 and 21 that Triano's NGW/DLE does not read on the claimed network device that includes a processor to send a call request message to the called endpoint, wherein the call request message includes a delayed call establishment capability advertisement. The Examiner respectfully disagrees. As shown in Fig. 2, Triano clearly teaches that an INVITE message for alerting the called user (SIP-UA/TU) that a CCBS supervision session can be started from called user acceptance on is sent from the NGW/DLE to the SIP-UA/TU, col. 7, lines 32-36. Therefore, since there is no difference in the structure or function between Triano's NGW/DLE and the claimed network device, it is respectfully submitted that the claim limitation is met. Accordingly, the rejection is maintained.

Regarding the arguments in the Remarks on pages 12-13 regarding claim 1 that Yoo's COT check included in the IAM message from the terminating gateway controller does not read on the claimed delayed establishment capability advertisement. The Examiner respectfully disagrees. It is noted that the features upon which applicant relies (i.e., the function(s) of the delayed call establishment capability as defined in the specification on page 1, lines 4-9) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, as there is not structural or functional difference between COT check of Yoo and the claimed delayed establishment capability advertisement, it is submitted the claim limitation is met. Moreover, even when interpreted in light of the specification, Yoo's COT check is consistent with "the capability to initiate a call without completing it, delay alerting the called user" as disclosed in the specification, page 1, lines 4-9 because Yoo clearly teaches that the COT check must be successfully finished before the terminating PSTN can seize the terminating subscriber and send a ring (col. 11, lines 17-19).

Accordingly, the rejection is sustained.

Regarding the arguments in the Remarks on page 13 regarding claims 5 and 26 that Donovan's QoS in the SIP INVITE does not correspond to the claimed delayed call establishment capability advertisement. The Examiner respectfully disagrees. It is noted that the features upon which applicant relies (i.e., the function(s) of the delayed call establishment capability as defined in the specification on page 1, lines 4-9) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, as there is not structural or functional difference between (a) Donovan's QoS in the SIP INVITE message 6 shown in Fig. 2 which advertises to SIP2 152 in Fig. 2 that SIP 1 150 supports end-to-end QoS assurance before ringing the called party (col. 4, lines 15-21, 34-39 and col. 6, lines 63-65) and (b) the claimed delayed establishment capability advertisement, it is submitted the claim limitation is met.

Moreover, when interpreted in light of the specification, Donovan's QoS is consistent with "the capability to initiate a call without completing it, delay alerting the called user" as disclosed in the specification, page 1, lines 4-9, because Donovan clearly teaches that the called telephone will not ring until policy has been provisioned in the network elements and resources have been reserved end-to-end to ensure an acceptable level of QoS (col. 4, lines 34-39 and col. 6, lines 63-65).

In addition, in the Remarks of the Amendment dated 12/13/2007 responding to the Non-final Office action dated 9/13/2007, the applicant failed to argue on the rejection based on Donovan on to this limitation (with an exception of the limitation "the delay point indicating at least one of feature discovery of the called endpoint and call supplementary services"), therefore, it is submitted that the applicant clearly agreed with the rejection that Donovan the limitation as claimed.

Thus, the claim limitation is clearly met by Donovan and the rejection is sustained.

Regarding the arguments in the Remarks on page 14 that claims 11 and 25 which depend from nonobvious independent claims are nonobvious and cited MPEP 2143.03 for support. The Examiner respectfully disagrees. Note that MPEP 2143.03 discloses that all claim limitations must be considered and has nothing to do with nonobvious claim depending from independent obvious claim. And since all limitations in the independent claims from which claims 11 and 25 depend and the limitations in claims 11 and 25 are clearly addressed in the rejection in the Final Office action dated 3/13/2008, the rejection is in compliant with MPEP 2143.03.

In addition, since the applicant fails to point out specifically why claims 11 and 25 are nonobvious, it is respectfully submitted that the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, for claim 11, it is well known in the art that a Setup message of H.323 protocol is equivalent to an INVITE message of the SIP protocol so it would have been obvious to one skilled in the art to utilize H.323 protocol to transmit an H.323 Setup message as an alternative to SIP, and for claim 25, Riikonen suggests that SIP application server may be used between the caller and the callee so it would have been obvious to one skilled in the art to include a SIP application server in the calling endpoint as an intermediary to act as the gateway for the calling endpoint (Riikonen, paragraph 0031).

Accordingly, the rejection is sustained.